



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/524,236

02/10/2005

Matthias Heinrich

1093-125 PCT/US

8667

23869 7590 08/06/2008  
HOFFMANN & BARON, LLP  
6900 JERICHO TURNPIKE  
SYOSSET, NY 11791

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

08/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,236	<b>Applicant(s)</b> HEINRICH ET AL.	
	<b>Examiner</b> ALICIA CHEVALIER	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/22/07, 2/10/05</u>                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-28 are pending in the application, claims 20-27 are withdrawn from consideration.
2. Amendments to claims, filed on February 10, 2005, have been entered in the above-identified application.

### ***Election/Restrictions***

3. Applicant's election without traverse of Group I, claims 1-19 and 28, in the reply filed on May 28, 2008 is acknowledged.
4. Claims 20-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 28, 2008.

### ***Specification***

5. The disclosure is objected to because of the following informalities: the specification lacks section heads. See MPEP § 601 for the preferred form and content of an application.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1794

7. Claims 1-19 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “IMD-film” in claim 1 is unclear and renders the claim vague and indefinite. It is unclear what “IMD” means, e.g. in-mold decorating, implantable medical device, inter-metal dielectric, integrated messaging device, etc.

The term “deep-drawable film” in claim 1 is unclear and renders the claims vague and indefinite. It is unclear what type of film constitutes “deep-drawable,” e.g. extrudable, castable, etc.

The phrase “wherein the optical effect of the spatial structure is *extinguished* in a pattern configuration” in claim 2 is unclear and renders the claims vague and indefinite. It is unclear how the spatial structure is “extinguished.” Does this just mean that the spatial structure contains a pattern or that the spatial structure is discontinuous and therefore forms a pattern, etc.

The phrase “wherein the intermediate layer comprises one or more *extinguishing* lacquer layers” in claims 3 and 4 is unclear and renders the claims vague and indefinite. It is unclear what constitutes an “extinguishing lacquer layer.” Does this just mean that the lacquer layer is added or that the lacquer layer is discontinuous, etc.

8. Claim 28 provides for the use of a multi-layer film, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 28 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-19 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Chatwin et al. (U.S. Patent No. 5,310,222).

Chatwin discloses a multilayer film which comprises a transparent structure layer which has a spatial structure producing an optically perceptible effect and a reflection layer arranged beneath the structure layer in a viewing direction (*col. 6, lines 61-68*).

The preamble “for the production of a decorated article which has a base body decorated with the multi-layer film and having curved surface regions” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The limitations “IMD” and “deep-drawable” are method limitations and do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

11. Claims 1-19 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Stump et al. (U.S. Patent No. 5,835,271).

Stump discloses a multilayer film which comprises a transparent structure layer (*col. 4, lines 41-43*) which has a spatial structure (*col. 4, line 42*) producing an optically perceptible effect (*retroreflection*) and a reflection layer (*col. 4, line 43*) arranged beneath the structure layer in a viewing direction (*figure 1*).

The preamble “for the production of a decorated article which has a base body decorated with the multi-layer film and having curved surface regions” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The limitations “IMD” and “deep-drawable” are method limitations and do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

The optical effect of the spatial structure is extinguished in a pattern configuration by means of an intermediate layer which is shaped in pattern form and which is arranged between the structure layer and the reflection layer and/or by means of removal in a pattern configuration, in particular demetalization, of the reflection layer in regions in which the curvature of the base body to be decorated with the multi-layer film and thus a curvature of the spatial structure on the decorated article exceeds a limit value, wherein a) the limit value is either a radius of curvature at which changes in the optical effect of the spatial structure, which are visible to a viewer of the decorated article, occur due to bending of the structure layer, or b) the limit value is a radius of curvature at which breaks occur in the structure layer (*figure 2 and col. 6, line 65-col. 7, line 8*).

The intermediate layer comprises one or more extinguishing lacquer layers which comprise a transparent material and which level the structure of the structure layer in a pattern configuration (*figure 1 and col. 4, lines 41-43*). The intermediate layer comprises a thermoplastic material (*col. 5, lines 51-64*). The flexibility of the intermediate layer is deemed to be different from that of the structure layer, since they are made of different materials (*col. 5, lines 38-64*). The intermediate layer and/or the structure layer is colored (*col. 7, lines 17-19*).

The limitation “wherein the intermediate layer has a masking layer which is partially removed with the post-applied part of the reflection layer” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

The structure layer has desired-fracture locations so that the structure layer breaks up in a defined fashion in regions in which a curvature of the structure layer in a curved surface region exceeds a limit value (*col. 6, line 65-col. 7, line 8*). The desired-fracture locations are so arranged that the optical effect produced by the structure is not impaired by the fracture of the structure layer in the region of the desired-fracture locations (*figure 13*). The desired-fracture locations are so arranged that the optical effect produced by the structure is no longer produced in regions in which the structure layer has broken up (*col. 6, line 65-col. 7, line 8*). The reflection layer has desired-fracture locations so that the reflection layer breaks up in a defined fashion in regions in which a curvature of the structure layer in curved surface regions exceeds a limit value, thereby extinguishing the optical effect produced by the structure in said regions (*col. 6, line 65-col. 7, line 8*).

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished



Art Unit: 1794

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alicia Chevalier/

Primary Examiner, Art Unit 1794

8/6/2008